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Peter Jones

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05/06/2008

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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

3696

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,798	Applicant(s) JONES ET AL.	
	Examiner WILLIAM E. RANKINS	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Status of Claims

Claims 1-18 and 31-37 are pending in this application. Claims 19-30 have been withdrawn according to the restriction election without traverse by applicant on August 7, 2007.

Response to Arguments

Nonstatutory Double-Patenting Rejections

1. Applicant's arguments, see pages 1 and 2 of amendment and response, filed 12/17/2007, with respect to the non-statutory double patenting rejection of claims 31-34, and indication of allowability have been fully considered and are not persuasive. The obviousness-type double patenting rejection is maintained and rejection of claims 31-34 under 35 U.S.C. 103(a) is indicated below.

Claim Rejections - 35 USC § 102

2. Claims 1-4 and 16 are rejected under 35 U.S.C. 102(b) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000,

December) by Jason Fargo (Fargo).

Reconsideration and withdrawal of the rejections is respectfully requested.

Claim 1 recites a method, comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual card and said dual card account being inactive until activated.

Fargo does not teach or suggest the method of claim 1.

Fargo states that Sears, Roebuck and Co., the nation's largest store card issuer, began moving some 7 million inactive holders of its proprietary card to co branded Sears MasterCards.

However, such statement does not teach or suggest selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform.

The Office Action asserts that in converting proprietary card accounts to co-branded accounts, non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank (see Office Action, page 7, final line-page 8, first line). Applicants respectfully disagree.

The mere statement that inactive holders of the proprietary card are moved to co branded Sears MasterCardS cannot possibly stand for a universal proposition that teaches selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform.

Indeed, if the position of the Office Action is that selecting a private label account maintained on a first processing platform for upgrade to a dual card account and creating said dual card account on a second processing platform is inherent in moving inactive holders to co branded Sears MasterCardS, Applicants respectfully submit that such position is improper (see MPEP 2112 (IV) " 'to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present'... [i]nherency... may not be established by probabilities or possibilities"), citing In re Robertson, 169 F.3d 743,745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added).

For at least the reasons above, Fargo does not teach or suggest a method, comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data; creating said dual card account with a zero balance on a second processing platform; transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account; and causing a dual card associated with said dual card account to be transmitted to account holder, said dual

card and said dual card account being inactive until activated, as recited in claim 1.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

3. Applicant's arguments, see page 2, lines 11-27 - page 4, lines 1-3, filed 12/17/2007, with respect to the rejection(s) of claim(s) 1-4 and 16 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new prior art found.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Fight for Retail Credit, Jason Fargo. Credit Card Management. New York: Dec 2000. Vol. 13, Iss. 9 in view of Gillin et al. (7,254,557), Brake Jr. et al. (6,032,136) and CardWeb.com (Kmart MasterCard (9/26/2000), Steele et al. (2005/0021456 A1), Fisher et al. (US 2003/0139978), Examiner's Official Notice, "Kmart Platinum Rocks!" Posted by: Jazzy Jazz, Date: 2/25/2003 and Fitzmaurice et al. (6,742,704).

As per claim 1;

Fargo discloses:

A co-branding method wherein, Sears selects proprietary cardholders for conversion to a co-branded Sears MasterCard account and Kmart converts its private label program to a Kmart MasterCard issued by Capital One Bank (Pg. 2, Para. 2 – Pg. 3, Para. 1). Fargo goes on to say that Kmart's private label program was previously run by Household Bank but the co-branded card program will be run by Capital One Bank (Pg. 6, Para. 4). The examiner asserts that this disclosure amounts to the selection of private label accounts on a first processing platform (household bank) for upgrade to dual card accounts on a second processing platform (Capital One Bank).

Fargo does not disclose:

Cardholder accounts having associated monetary and non-monetary data, creating dual card accounts with a zero balance, transferring said monetary and non-monetary data, causing said dual card account to be transmitted to the cardholder and said dual card account being inactive until activated.

However, Gillin et al. discloses:

Financial services card accounts, including co-branded cards, initially issued with a zero balance and a credit limit (Col. 13, lines 48-52) and, in accordance with normal practices, delivering the card to the cardholder and requiring the cardholder to activate the card prior to use (Col. 18, lines 40-45).

Additionally, Brake Jr. et al. discloses:

A multi-value card with a balance transfer option from another credit card. During the balance transfer process the name of the credit card from which the balance is to be transferred, the account number and balance (Col. 10, lines 19-35). The examiner asserts that this amounts to the transfer of monetary and non-monetary data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al. and Brake Jr. et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so as these procedures amount to standard and/or common business practices of transferring information from one credit card to another and issuing new credit cards to customers.

As per claim 2;

Fargo does not disclose:

Receiving conversion requests via frontline associates, voice response or web site.

However, Card Web discloses:

The marketing of co-branded cars via store, on-line or telephone (Pg.1).

Additionally, Card Web discloses:

The marketing of new cards via in store promotions and 'take one' applications.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al. and

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Card Web. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to use commonly used and accepted marketing methods.

As per claim 3;

The examiner cites and maintains the rejection in the previous office action.

As per claim 4;

Fargo discloses:

Communicating the upgrade opportunity to upgrade the private label account to a dual card account (Pg. 7, para. 1).

As per claim 5;

Fargo does not disclose:

The method of claim 1, further comprising: receiving an activation request from said account holder;

confirming that said account holder remains eligible for said dual card account; and activating said dual card account.

However, Brake Jr. et al. discloses:

Receiving an activation request from a customer (Col. 3, lines 29-54) and performing an eligibility check before activating the multi-value card (Col. 8, lines 16-23).

Therefore it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al. and Brake Jr. et al.

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One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to gauge the initial interest in the card program and to protect the financial interests of the issuer.

As per claim 6;

Fargo does not disclose:

The method of claim 5, further comprising: retrieving said non-monetary data from said second processing platform; and confirming with said account holder that said non-monetary data is accurate.

However, Steele et al. discloses: (pg. 4, paragraph 0037) "In step 220, information is sent regarding the converted financial institution account to the customer. Information may be sent for the customer's review and also a confirmation from a customer may be required. The information may be forwarded to the customer in a number of ways, including, for example, email or regular mail".

Therefore it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al., and Steele et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide security to the card holder and the issuer and prevent fraudulent activity.

As per claim 7;

Fargo does not disclose:

The method of claim 5, further comprising: transferring said monetary data from said first processing platform to said second processing platform; and blocking said private label account from further use.

However, Fitzmaurice et al. discloses combined card services that, in the replacement process, transfer account information from one system to another (Col. 3, lines 43-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al. and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to effectively replace credit cards.

As per claim 8;

Fargo does not disclose:

The method of claim 7, further comprising: initiating a trailing activity process to identify monetary and non-monetary activity associated with said private label account.

However, Fitzmaurice et al. discloses (col. 3, line 20-25), "It would also be advantageous to have a card that contains a bar code that may be scanned at the point of sale when customers make purchases so that the scanned data may be forwarded directly to the service partner's systems for reporting and tracking purposes."

Therefore, It would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al. and Fitzmaurice et al.

As per claim 9;

Fargo does not disclose:

The method of claim 8, wherein said initiating said trailing activity process includes updating a cross reference table associating said private label account and said dual card account.

However, Fitzmaurice et al. discloses, in a multiple-service card system, (Abstract) "This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility.

Therefore, It would have been obvious to one of ordinary skill in the art to combine the methods of Fargo, Gillin et al., Brake Jr. et al., and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to associate activity in one account with activity in the other.

As per claim 10;

Fargo does not disclose:

The method of claim 1, wherein said non-monetary data includes data identifying said cardholder.

However, Fitzmaurice et al. discloses: (abstract) This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al. Brake Jr. et al. and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to properly identify the cardholder.

As per claim 11;

Fargo does not disclose:

The method of claim 1, wherein said selecting further comprises:
updating a status flag associated with said private label account to indicate that said account has been selected for said conversion to said dual card account.

However, Fisher et al. discloses; (Abstract, paragraph 1) "A method and system for providing order status information using an update status flag..."

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al., Fitzmaurice et al. and Fisher et al. One of ordinary skill in the art at the time of this

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invention would have been motivated to do so in order to track and monitor the progress of the card offering.

As per claim 12;

Fargo does not explicitly disclose:

The method of claim 4, further comprising: determining that said account holder has not declined said opportunity by determining that a time period for declining said opportunity has expired.

However, Official Notice is taken that it was old and well known in the art to limit the time for acceptance or use of special offers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al. and Official Notice. One of ordinary skill in the art would have been motivated to do so in order to make each offer as memorable to the consumer as possible and promote a response from the consumer. See MPEP 2144.03.

As per claim 13;

Fargo does not disclose:

The method of claim 1, wherein said private label account is identified by a private label account identifier and said dual card account is identified by a dual card account identifier, the method further comprising: generating a table including a cross-reference between said private label account identifier and said dual card account identifier.

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However, Fitzmaurice et al. discloses account identifiers associated with a cardholders account and used to create new account numbers to aid in the creation of a new card for that cardholder. (Col. 7, lines 10-15, Col. 9, line 53- 59, Col. 9, line 67 – col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al. and Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to associate the private-label merchant with the major credit card provider.

As per claim 14;

Fargo does not disclose:

The method of claim 1, wherein said private label account is associated with a private label merchant, the method further comprising: generating account information associated with said dual card account, said account information including an overall credit limit and a retailer reserve presented to said account holder, said retailer reserve usable for purchases at said private label merchant.

However, Jazzy Jazz discloses the following about the Kmart MasterCard: “It is kind of confusing at first staying within the split limit, but they did start me out with a \$500 limit, \$300 which could be used outside of Kmart.”

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake et al., and

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Jazzy Jazz. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to promote spending at the private label account.

As per claim 15;

Fargo does not disclose:

The method of claim 14, wherein said generating account information further comprises generating a rate associated with said dual card account.

However, cardweb.com discloses: "Kmart MasterCard cardholders will receive benefits such as special promotions and a 0% interest rate for six months on all Kmart purchases made with the new MasterCard. The APR for non-Kmart purchases and for Kmart purchases after the intro period is prime +10.3%. There is no annual fee for the new MasterCard."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake et al., Jazzy Jazz and Card Web. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to completely disclose the offer to the consumer.

As per claim 16:

The examiner cites and maintains the basis for rejection in the previous office action.

As per claim 17;

Fargo does not disclose:

The method of claim 16, wherein said creating said dual card includes at least one of: (1) embossing a magnetic stripe card with said account holder information and a dual card account identifier; and (2) storing information identifying said account holder and a dual card account identifier in a memory of a smart card.

However, Fitzmaurice et al. discloses (abstract) "This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al., and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide the functionality of two card issuers in one card.

As per claim 18;

Fargo does not disclose:

The method of claim 1, wherein said dual card account has a dual card account identifier routable over both a private label network and a bankcard network.

However, Fitzmaurice et al. discloses (Summary of the Invention, paragraph 1),:

The present invention provides a system and method for providing consumers with the benefits of multiple cards while allowing consumers to carry a single card. To accomplish this advantage, the system and method of the present invention enables a single card to function in multiple modes, for example, as both a credit card and a separate service partner's membership card. By providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers, the present invention eliminates the disadvantages of the prior art systems such as, for example, the requirement to join, through use of a hinge and a fastener, multiple card segments or the requirement to embed multiple magnetic stripes into the consumer's card. (Col. 5, lines 49-53) The primary party 102 and the service partner 106 both comprise computing units or systems, which communicate with and through a card service engine 104, and all of which are connected with each other via a data communication network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al., Brake Jr. et al., and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide the functionality of two card issuers in one card and facilitate purchase transaction activity.

5. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,945,653), in view of Woods et al. (4,813,077), Adams (5,255,182), Myatt (5,231,569), INDUSTRY BRIEFS, Card News. Potomac: Dec 22, 1997. Vol. 12, Iss. 25

and The Fight for retail credit, Jason Fargo. Credit Card Management. New York: Dec 2000. Vol.13, Iss. 9., Fitzmaurice et al. (6,742,704) and Spear (2002/0138428).

As per claim 31;

Walker et al. discloses:

A method for routing a transaction, comprising:

generating an authorization request, said request including a transaction amount and an account identifier, said account identifier including a portion identifying an issuer of said account (abstract, Col. 1, lines 24-28).

Walker et al. does not disclose:

and a portion identifying a type of said account;

routing said authorization request to said issuer via a first authorization network if said account identifier indicates that said account is a first type of account; and

routing said authorization request to said issuer via a second authorization network if said account identifier indicates that said account is a second type of account.

However, Woods et al. discloses:

The cardholder number or account number which identifies the account type (Col. 8, lines 46-49).

Additionally, Adams discloses:

Using different payment processing networks depending upon whether the issuer is the merchant member bank or not (Col. 2, lines 24-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Walker et al. Woods et al. and Adams. One of ordinary skill in the art at the time of this invention would have been motivated to do so as this processing method was old and well known at the time.

As per claim 32;

Walker et al. discloses:

Routing an authorization request including information comprising an amount and an account identifier as disclosed in the rejection of claim 31.

Walker does not disclose:

A method for operating a private label processing platform, comprising:

receiving, from a private label processing network, an authorization request, said authorization request including information identifying, a merchant;

determining that said account identifier is an identifier of a dual card account; and forwarding said authorization request to a dual card processing platform for authorization.

However, Card News discloses:

A transaction authorization contract between Chase Manhattan Bank and Dillard's department store (pg. 2, Para. 5).

Also, Fargo discloses:

A Sears MasterCard that open a new revenue stream for Sears since Sears is its own issuer and will earn interchange fees on purchases made elsewhere (Pg. 11, Para. 2).

Additionally, Myatt discloses:

Communicating an authorization request to a transaction processor, the transaction processor responding to the authorization request (Col. 5, lines 12-14 and Col. 6, lines 1-5).

And Woods et al. discloses:

A bank copy of a deposit transmittal including a merchant ID (Col. 7, lines 36-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Walker et al., Woods et al., Adams, Myatt, Fargo and Card News. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to reduce processing costs and interchange fees associated with routing transactions through the major credit card networks.

As per claim 33;

Walker et al. does not disclose:

The method of claim 32, wherein said account identifier is associated with an inactive private label account, the method further comprising:

determining whether any trailing activity is associated with said inactive private label account.

However, Fargo discloses:

Moving inactive private label accounts to co branded accounts (Pg. 2, Para. 1).

And Fitzmaurice et al. discloses:

Balance reports and records of invalid or replaced cards forwarded to card replacement administrators.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Walker et al., Woods et al., Adams, Myatt, Fargo, Card News, and Fitzmaurice et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to keep updated records of account holders.

As per claim 34;

Walker et al. does not disclose:

The method of claim 32, further comprising:

determining that no stand in authorization rules apply to said authorization request prior to forwarding said authorization request.

However, Spear discloses:

An acquiring entity that seeks authorization from the issuing entity (Para. 0023).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Walker et al., Woods et al., Adams, Myatt, Fargo, card News and Spear. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to avoid interchange fees.

6. Applicant's arguments see pages 13-18 of amendment and response filed 12/17/2007, with respect to claims 35-37 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new prior art found.

7. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over The fight for retail credit, Jason Fargo. Credit Card Management. New York: Dec 2000. Vol. 13, Iss. 9 in view of Gillin et al. (7,254,557), Brake Jr. et al. (6,032,136) and Blagg (US 2004/0049452 A1).

As per claim 35;

Fargo discloses:

A co-branding method wherein, Sears selects proprietary cardholders for conversion to a co-branded Sears MasterCard account and Kmart converts its private label program to a Kmart MasterCard issued by Capital One Bank (Pg. 2, Para. 2 – Pg. 3, Para. 1). Fargo goes on to say that Kmart's private label program was previously run by Household Bank but the co-branded card program will be run by Capital One Bank (Pg. 6, Para. 4). The examiner asserts that this disclosure amounts to the selection of private label accounts on a first processing platform (household bank) for upgrade to dual card accounts on a second processing platform (Capital One Bank).

Fargo does not disclose:

Cardholder accounts having associated monetary and non-monetary data, creating dual card accounts with a zero balance, transferring said monetary and non-monetary data, causing said dual card account to be transmitted to the cardholder and said dual card account being inactive until activated.

However, Gillin et al. discloses:

Financial services card accounts, including co-branded cards, initially issued with a zero balance and a credit limit (Col. 13, lines 48-52) and, in accordance with normal practices, delivering the card to the cardholder and requiring the cardholder to activate the card prior to use (Col. 18, lines 40-45).

Additionally, Brake Jr. et al. discloses:

A multi-value card with a balance transfer option from another credit card. During the balance transfer process the name of the credit card from which the balance is to be transferred, the account number and balance (Col. 10, lines 19-35). The examiner asserts that this amounts to the transfer of monetary and non-monetary data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Fargo, Gillin et al. and Brake Jr. et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so as these procedures amount to standard and/or common business practices of transferring information from one credit card to another and issuing new credit cards to customers.

Fargo also does not disclose:

A payment card processing apparatus, comprising:

A processor; and a storage device in communication with said processor and storing instructions adapted to be executed by said processor.

However, Blagg discloses:

(pg. 4, paragraph 0040) Further, computer 210 includes a communication device (not shown) that allows computer 210 to communicate via communication network 110. Such a communication device can be any device or combination of devices capable of interfacing to communication network 110, such as, an internal modem, an external modem, an Ethernet card, or the like. In addition, computer 210 includes various forms of memory such as random access memory (RAM), and disk memory such as a hard disk drive. Such memory provides a computer readable medium that includes computer executable instructions that are executed by a processor of computer 210 to perform the various functions associated with transaction processor 120.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the teaching of Fargo with Blagg et al. in order to facilitate the process of establishing a dual account.

Claims 36 and 37 are rejected under the same rationale used to reject claim 35. In addition, the examiner asserts that claim 36 is intended to invoke 35 U.S.C. 112, 6th Paragraph and is treated as such.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/W. E. R./
Examiner, Art Unit 3696, 2/15/08

/Daniel S Felten/
Primary Examiner, Art Unit 3696